

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Gelfand et al.

Serial No.: 07/873,897

Filed: April 24, 1992

For: PURIFIED THERMOSTABLE ENZYME



Art Unit: 1651

Examiner: D. Naff

**THIRD SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT**  
**UNDER 37 C.F.R. § 1.56 and § 1.97**

Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

Attorneys for Applicants submit this Third Supplemental Information Disclosure Statement to bring to the Examiner's attention the decision of the District Court of the Northern District of California dated December 7, 1999 ("December 1999 Decision") in the February 1999 inequitable conduct trial in the litigation of United States Patent No. 4,889,818 (the "'818 patent"),<sup>1</sup> which issued from application Serial No. 07/069,509, filed June 17, 1987, of which the grandparent of the captioned application is a continuation-in-part application.<sup>2</sup> The District Court held all claims of the '818 patent unenforceable for inequitable conduct.

<sup>1</sup> The litigation is currently pending in the Northern District of California, *Hoffmann-LaRoche Inc. and Roche Molecular Systems, Inc. v. Promega Corporation*, Civil Action No. C-93-1748 VRW ("Roche v. Promega '818 Patent Litigation").

<sup>2</sup> The present application is a file wrapper continuation of application Serial No. 07/387,003, filed July 28, 1989, which is a divisional of application Serial No.

In the Second Supplemental Information Disclosure Statement, filed October 7, 1999, Applicants brought the Roche v. Promega '818 Patent Litigation to the attention of the Patent and Trademark Office and submitted the pre-trial and post-trial briefs filed by both parties in connection with the February 1999 inequitable conduct trial. In the Second Supplemental Information Disclosure Statement, Applicants indicated that the parties were awaiting a decision of the Court on the inequitable conduct trial. Applicants received the December 1999 Decision on December 7, 1999 and herein request that the December 1999 Decision be made of record in the captioned application. Applicants recognize that a large volume of materials, such as laboratory notebooks and internal memoranda, underlie the December 1999 Decision. As not to overburden the Patent and Trademark Office, Applicants have not provided these underlying materials herewith. However, the Examiner is invited to contact the undersigned for copies of any and all such materials as the Examiner may deem pertinent to the subject matter claimed in the captioned application.

The December 1999 Decision is listed on the attached revised form PTO 1449 entitled "List of References Cited by Applicant," and a copy of the December 1999 Decision is submitted herewith. Identification of the listed reference is not to be construed an admission of Applicants or Attorneys for Applicants that such reference is available as "prior art" against the subject application. Consequently, Applicants respectfully decline to use form PTO-1449, since this form identifies all of the references cited therein as "Prior Art." As an alternative,

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07/387,003, filed July 28, 1989, which is a divisional of application Serial No. 07/143,441, filed January 12, 1988, which is a continuation-in-part of application Serial No., 07/063,509, filed June 17, 1987, which issued as the '818 patent.

Applicants submit herewith a "revised form PTO 1449" entitled "List of References Cited" instead of "List of Prior Art Cited."

As this Third Supplemental Information Disclosure Statement is being submitted after the mailing of a Notice of Allowance under 37 C.F.R. § 1.311 but before the filing of the issue fee, pursuant to 37 C.F.R. § 1.97(d), the Patent and Trademark Office will consider the Statement if the Statement is accompanied by the certification specified in 37 C.F.R. § 1.97(e) and a petition requesting consideration of the Statement with the appropriate petition fee.

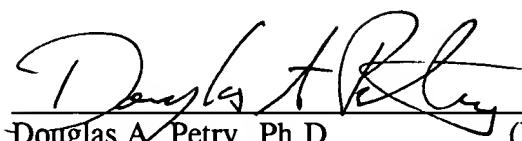
Accordingly, the undersigned certifies pursuant to 37 C.F.R. § 1.97(e) that the December 1999 Decision cited in this Third Supplemental Information Disclosure Statement, which was released by the Court only a few days prior to the filing of this Statement, was not cited in a communication from a foreign patent office in a counterpart foreign application and, to the knowledge of the undersigned after making a reasonable inquiry, the December 1999 Decision was not known to any individual designated in 37 C.F.R. § 1.56(c) more than three months prior to the filing of this Third Supplemental Information Disclosure Statement.

Additionally, pursuant to 37 C.F.R. § 1.97(d), submitted herewith is a Petition Requesting Consideration of Information Disclosure Statement Under 37 C.F.R. § 1.97(d)(2) with the required fee.

Applicants submit that the requirements for consideration of an Information Disclosure Statement after the mailing date of a Notice of Allowance but before payment of the issue fee have been met. Thus, Applicants respectfully request that the Examiner review the foregoing reference and that the reference be made of record in the file history of the application.

Respectfully submitted,

Date: December 20, 1999

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